

January 19, 2001

In Claim 21, Line 3, please delete "system" and substitute therefor --composition--.

**IN THE ABSTRACT**

Please delete the text of the abstract currently present in the application and substitute therefor the following text:

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--Heterogeneous catalytic compositions obtained by reacting a porous inorganic support with an alumoxane and subsequently supporting at least one metallocene compound thereon. A process for polymerization of  $\alpha$ -olefins in a slurry or in a gas phase, the process catalyzed by such heterogeneous catalytic compositions.--

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**REMARKS**

1. The Examiner rejected Claims under 35 USC §112, Second Paragraph for alleged indefiniteness. In response, the Applicant made a number of amendments and respectfully submits that all the claims are now definite.

2. In particular the Applicant

- (a) re-numbered claims as suggested by the Examiner and corrected the dependencies;
- (b) replaced the term "system" with the term "composition" throughout the specification and claims;
- (c) replaced the expression "obtainable" with the expression "obtained by";
- (d) amended formulae II and III, because the integer "m" was meant to include both Q and the ligands attached to it; and
- (e) amended the abstract.

3. In the second sentence in Item 6 on Page 3 of the Office Action, the Examiner expressed concerns that some claims may be indefinite and asked to clarify whether the support must have the presence of surface -OH groups in order to react with alumoxane, followed by the reaction with the siloxane groups of the then added metallocenes.

In response, the Applicant wishes to point out that, prior to the above-mentioned reaction with the metallocene, the inorganic support is treated in such a way as to have alumoxane deposited on the surface of the support. A method of such treatment of the

support can be selected from a number of available methods known to those skilled in the art.

4. The Examiner rejected Claims 1-7 and 10-19 (as re-numbered) under 35 U.S.C. §102(a) as allegedly anticipated by the European Patent document EP 0 802 203 to Hidalgo Linas. The Applicant respectfully traverses this rejection on the ground that Hidalgo Linas does not describe the same processes and products as claimed in Claims 1-7 and 10-19 of this invention.

5. The Examiner also rejected Claims 1-7 and 10-19 under 35 U.S.C. §103(a) as being obvious over Hidalgo Linas, and further rejected Claims 1-7 and 10-19 on the same grounds over EP 0 372 414 (Antberg) in view of EP 0 206 794 (Welborn) . The Applicant respectfully disagrees.

It is well established law, that in order to be able to reject a claim under §103(a)

"the scope and content of the prior art  
are to be determined; differences between

the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved."

Graham v. John Deere, 383 U.S. 1, 148 U.S.P.Q. 459 (1966).

In view of the seminal John Deere case and other relevant authorities, the USPTO set a procedure which must be followed by examiners when a claim is rejected under Section 103. In particular, when, as here, in order to be able to reject a claim on the obviousness ground, it is necessary to modify a prior art reference or combine more than one prior art reference, the Examiner must point out what relevant teachings of prior art relied upon are; what the differences between the limitations of the claim and teachings of the prior art are and that the proposed modification or combination is necessary to arrive at the claim subject matter. Furthermore, the Examiner must explain why one ordinarily skilled in the art at the time of the invention was made would have been motivated to make such modification or combination. MPEP, §706.02(j).

MPEP Section 706.02(j), based on the authority of In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991), further

requires that in order to establish that the proposed modification or combination is necessary, the references themselves (or at least general knowledge in the art) must give some suggestion or motivation to so modify or combine the references. See also In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) and Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). MPEP further requires that such standard, based on John Deere, be followed in every case, MPEP §2141, and that the examiner clearly set forth his or her reasoning as to why the modification or combination is necessary. Ex parte Clapp, supra; MPEP §§ 706.02(j) and 2144-2144.09.

It is the Applicant's contention that in the Office Action the Examiner did not satisfy any of the above-stated standards. In particular, the Examiner did not provide an explanation why claims are allegedly obvious in view of the prior art he cited.

He did not show why a person of ordinary skill in the art at the time of the invention was made would modify the teachings of Hidalgo Linas, since Hidalgo Linas neither suggests such

modifications nor motivates person of ordinary skill in the art to make them.

Furthermore, the Examiner did not clearly state why the references that he cited (Antberg and Welborn), would either suggest to a person of ordinary skill in the art at the time of the invention was made to combine the teachings of the references or motivate such person to make such combination. Indeed, these prior art documents are not properly combinable.

It was held in *In re Vaeck* that the cited references themselves must provide the teaching, motivation or suggestion to make the claimed combination. The combining cannot be based on the Applicant's disclosure. See, MPEP §706.02(j). As pointed out above, Antberg and Welborn do not provide such teaching, motivation or suggestion to make the claimed combination.

It appears that the Examiner read the disclosure of this invention and only then did it occur to him that there is a possibility to combine with the of. There is no other reasonable explanation because he could not find this in the two references. Such "hindsight" reconstruction is, of course, impermissible.

In view of the foregoing, one can make an unescapable conclusion that the 103(a) rejection over combination is erroneous and should be withdrawn by the Examiner.

6. It is respectfully submitted, that this application is in condition for allowance. Allowance of the application at an early date is solicited.

7. This response amends Claims without prejudice. The amendments and additions described in the preceding sentence were done to claim the scope of the invention that the Applicant is entitled to claim and were not necessarily done to overcome the prior art. The cancellations, amendments and additions described in the first sentence of this paragraph shall not be considered necessary to overcome the prior art.

8. The Applicant reserves the right to seek protection for any unclaimed subject matter either subsequently in the prosecution of the present case or in a divisional or continuation application.

9. The Commissioner is authorized to charge any additional fees

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which may be required or credit overpayment to Deposit Account No. 12-0415 and, in particular, if this Response is not timely filed, then the Commissioner is authorized to treat this Response as including a petition to extend the time period pursuant to 37 C.F.R. 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to Deposit Account No. 12-0415.

Respectfully submitted,



Victor Repkin  
Reg. No. 45,039  
LADAS & PARRY  
5670 Wilshire Blvd., Suite 2100  
Los Angeles, California 90036  
(323) 934-2300